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CENTRAL FAX CENTER****AUG 20 2005****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Applicant: Toyoshima )

Art Unit: 2687 )

Serial No.: 09/974,724 )

Examiner: Bhattacharya )

Filed: October 9, 2001 )

50P4257.04 )

For: WIRELESS MODEM MODULE SERVER SYSTEM )

August 19, 2005 )

750 B STREET, Suite 3120 )

San Diego, CA 92101 )

**SUPPLEMENTAL APPEAL BRIEF**

Commissioner of Patents and Trademarks

Dear Sir:

This brief responds to the attempt to reopen prosecution dated August 15, 2005. The appeal is reinstated.

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**(1) Real Party in Interest**

The real party in interest is Sony Corp.

**(2) Related Appeals/Interferences**

Appeals have been filed in related application serial nos. 09/972,183 and 09/972,781.

**(3) Status of Claims**

Claims 1-3, 5-10, and 30 are pending and twice rejected, and the remaining claims have been canceled.

**(4) Status of Amendments**

No amendments are outstanding.

**(5) Concise Explanation of Subject Matter in Each Independent Claim, with Page and Figure Nos.**

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 sets forth an apparatus for managing data for a wireless device (e.g., host unit 210, figure 3, page 6, lines 20-30) that includes a first memory for storing received data of a wireless device and a second memory for storing a network operational file (e.g., memories 160, figure 2, page 5, line 18). The

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operational file includes instructions for selecting a destination using a wireless module (e.g., device 100, figures 2 and 3, pages 5 and 6) of the wireless device. Instruction means are provided for operating the network operational file for sending the received data using the wireless module to the selected destination (bottom of page 6 to page 7, line 3). The instruction means sends the received data via a wireless path to an email address associated with the selected destination, page 8, first full paragraph.

Claim 30 sets forth a digital camera system including a digital camera (e.g., one implementation of the host unit 210, page 7, lines 11-21) and a wireless transceiver (100, id.) coupled to the camera. A memory (id.) is provided for storing digital photographs from the camera. Data is automatically sent using the wireless transmitter to a remote location via a network router when an amount of data stored in the memory reaches a threshold, page 7, lines 22-27.

**(6) Grounds of Rejection to be Reviewed on Appeal**

(a) Claims 1-3 and 5-10 have been rejected under 35 U.S.C. §103 as being unpatentable over Zegelin et al. (USPN 6,694,430) combined with Lee et al. (USPN 6,728,531).

(b) Claim 30 has been rejected under 35 U.S.C. §103 as being obvious over Bunte (USPN 6,330,975) in view of Lewis et al., USPN 5,294,792.

**(7) Argument**

In this procedurally puzzling case, the new examiner declares that the prior appeal brief was persuasive - and then repeats the rejections of all claims verbatim from the last examiner's final office action, complete with the original grammatical errors, adding only a single additional citation to Lee et al. for a

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teaching of email in a vacuum. Incredibly, while Claim 30 purports to be rejected on a new primary reference (Bunte), the body of the rejection repeats verbatim the prior rejection based on the old primary reference by name (Cook), relying on the exact same citations in Cook as before, and declaring that Examiner Vu, not Examiner Bhattacharya as indicated on the Office Action cover sheet, remains the examiner of record. Nonetheless, the SPE has approved reopening prosecution, obviously without any degree of actual supervisory review. Appellant expects that the case either will be sent to the Board or allowed, and that no further churning of prosecution will be encountered.

(a) The Office Action declares that the arguments made in the original brief and repeated below "are persuasive" - and then levies the exact same rejection except for citing an additional teaching of "email" in Lee et al. Accordingly, to repeat the argument the examiner has found to be "persuasive" while addressing the single new citation to Lee et al., the rejection of Claim 1 admits that the primary reference fails to teach an operational file that enables selection of a destination, and that it further fails to teach sending information to an email address associated with the selected destination - in other words, the primary reference fails to teach or suggest the heart of Claim 1. Appellant agrees that this deficiency exists in the prior art. Nonetheless, the missing requirements in Claim 1 including the recitation that the data is sent via a wireless path to an email address associated with the selected destination have been rejected because "it is inherently understood that the information transmissions to the server [in the secondary reference] include email transmissions".

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This is legal error. First, inherency is a doctrine of anticipation, not obviousness. Second, to be "inherent", a feature must *necessarily* be part of the prior art, MPEP §2112; mere possibilities are insufficient.

The newly relied-upon portions of the secondary reference (Lee et al.) mention only that email capability can be provided, but "email" in a vacuum is not being claimed. Instead, as set forth in Claim 1 a network operational file must include instructions for selecting a destination using a wireless module, with the operational file being operable to send received data using the wireless module to an email address associated with the selected destination. Appellant is not arguing that email itself is new; what is germane is that nothing in the relied-upon portions of Lee et al. mentions email in anything other than its conventional context. Thus, the use of email is not "necessary" in Lee et al. *in the context claimed* as is otherwise required to support an inherency finding.

Indeed, in Lee et al. email isn't used at all for any specified function. Instead, information from a vehicle is uploaded to an Internet gateway for later retrieval explicitly using a web browser, not email. Significantly, Lee et al. indeed is aware of email - it is one type of personal information that can be downloaded to the user from the Internet gateway - but nowhere does Lee et al. make the critical recognition which is reflected in Claim 1 that an email address may be the destination of data that is uploaded from the vehicle. Among other things, Lee et al. thus requires a browser to retrieve previously uploaded information, whereas a simple email-only device may be used to retrieve information in the invention of Claim 1. Accordingly, a proper *prima facie* case of obviousness cannot be made based on the references applied against Claim 1.

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(b) The rejection of Claim 30 uses either Bunte (as stated in the formal statement of rejection) or continues to use Cook (per the body of the rejection), so Appellant will address both. The rejection admits that Cook fails to teach or suggest the gravamen of the claim being rejected, namely, uploading data from a camera when an amount of data reaches a threshold, relying on a secondary reference (Lewis et al.) for the making up the deficiency. However, the pen of Lewis et al. does not envision network use. Instead, it motivates the skilled artisan to cause an automatic download only to a host computer that is nearby the pen. For this reason, even if Lewis et al. were to be combined with Cook, Claim 30, which requires a network router, would not result.

If Bunte was meant to be the primary reference, no citation to anything in it appears on the record, dooming any prima facie case purporting to be based on Bunte.

Moreover, Bunte is directed to periodically and automatically capturing images, with an optical path in one configuration for "coded" images and in another configuration for "photo images". Appellant has not been able to identify anything in this reference that uploads data from a camera when an amount of data reaches a threshold, meaning that it suffers from the fatal deficiency as the old reference (Cook).

Additionally, regardless of which primary reference is used, Lewis et al. is not analogous to the digital camera art either of Claim 30 or to the primary reference with which it is sought to be combined. Specifically, it has not been shown using evidence of record where the prior art or general knowledge in the art indicates that the wireless digital camera artisan would logically have consulted the handwriting recognition art, as is otherwise required by MPEP §2136 to establish analogousness. The examiner has responded by correctly noting what the law says about analogousness, but then demonstrates an incapacity to apply it by noting that Cook and Lewis et al. are both directed to wireless devices without comprehending


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that neither Claim 30 nor Cook are directed to "wireless devices" in general but rather to digital cameras. This has lead the examiner into the error of casting far too broad a net in defining what the relevant subject matter is. Lewis et al. simply is not analogous to the art actually recited in Claim 30, which is digital cameras, not "wireless devices".

Respectfully submitted,

  
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#### APPENDIX A - APPEALED CLAIMS

1. An apparatus for managing data for a wireless device, comprising:
  - a first memory for storing received data of a wireless device;
  - a second memory for storing a network operational file, said operational file including instructions for selecting a destination using a wireless module of said wireless device, and
  - instruction means for operating the network operational file for sending the received data using the wireless module to the selected destination, wherein the instruction means sends the received data via a wireless path to an email address associated with the selected destination.
2. The apparatus of Claim 1, wherein the first and second memories are located on the wireless module.
3. The apparatus of Claim 1, wherein the network operational file can be configured for the wireless device and the selected destination.
5. The apparatus of Claim 1, wherein the instruction means can send the received data in real time to a selected destination.
6. The apparatus of Claim 1, wherein a host can send data via the wireless module to the wireless device.
7. The apparatus of Claim 6, wherein the host can send data in real time via the wireless module to the wireless device.
8. The apparatus of Claim 1, wherein the wireless device is a digital camera, PDA, laptop, MP3 player, or a wireless flash memory device.
9. The apparatus of Claim 1, wherein the wireless device is connectable to an ISDN, Cellular or DSP network.
10. The apparatus of Claim 1, wherein the wireless module is integrated into the wireless device.
30. A digital camera system, comprising:
  - a digital camera;
  - a wireless transceiver coupled to the camera; and
  - a memory for storing digital photographs from the camera, data being automatically sent using the wireless transmitter to a remote location via a network router when an amount of data stored in the memory reaches a threshold.

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**APPENDIX B - EVIDENCE**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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**APPENDIX C - RELATED PROCEEDINGS**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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